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In re Application of FOX et al :
U.S. Application No.: 10/584,358 :
PCT Application No.: PCT/AU2004/001820 : DECISION
Int. Filing Date: 23 December 2004 :
Priority Date Claimed: 24 December 2003 :
Attorney Docket No.: 3276-7872US :
For: A SYSTEM FOR WATER TREATMENT :

This is in response to applicant's "Renewed Petition Under 37 C.F.R. 1.47(b)" filed 16 October 2007.

BACKGROUND

On 23 December 2004, applicant filed international application PCT/AU2004/001820, which claimed priority of an earlier Australia application filed 24 December 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 07 July 2005. The thirty-month period for paying the basic national fee in the United States expired on 24 June 2006.

On 23 June 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 02 March 2007, applicant filed a petition under 37 CFR 1.47(b).

On 16 May 2007, this Office mailed a decision dismissing the 02 March 2007 petition.

On 16 October 2007, applicant filed the present renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or

declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (3), (5), and (6) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventors John Fox and Errol O'Brien refuse to sign the application papers. With regard to inventor Fox, petitioner has not adequately demonstrated that a bona fide attempt was made to present a copy of the application papers (including specification, claims, drawings, and oath/declaration) to Fox for signature. Although a declaration was sent to Fox (see affidavit of Edgar Cataxinos, ¶2, and Exhibit A), it has not been shown that the specification, claims, and drawings were ever presented to Fox. Petitioner has, however, furnished sufficient evidence of Fox's refusal to cooperate. In particular, Fox made an express oral refusal to sign during a telephone conversation (see affidavit of Nancy Johnson, ¶1). With respect to inventor O'Brien, although it appears that a bona fide attempt was made to present a copy of the applications papers to O'Brien for signature (see Exhibit F, letter from Nancy Johnson), an affidavit from Ms. Johnson, the person who made such attempt, has not been furnished. Petitioner has, however, supplied adequate evidence of O'Brien's refusal to sign. In particular, even though O'Brien stated that he is not refusing to sign in the letter dated 11 October 2007, O'Brien nevertheless declined to return an executed declaration and made clear that he is unwilling to proceed under present conditions, which is deemed a constructive refusal to cooperate. Therefore, before it can be concluded that inventors Fox and O'Brien refuse to join in the application, petitioner must: (1) demonstrate that a bona fide attempt was made to present Fox with the specification, claims, and drawings and (2) provide an affidavit from Ms. Johnson

stating that the specification, claims, and drawings were included with the letter sent to O'Brien on 20 September 2007.

With regard to item (4) above, a declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors has been provided.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136. Failure to respond in a timely manner will result in ABANDONMENT of the present application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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